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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,888	10/01/2004	Andrew J. Mayhew	36-1859	9785
23117 7590 01/07/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
SINGH, SUNIL				
ART UNIT		PAPER NUMBER		
3672				
MAIL DATE		DELIVERY MODE		
01/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/509,888

**Applicant(s)**

MAYHEW ET AL

**Examiner**

Sunil Singh

**Art Unit**

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 6 and 8-13 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5, 7, 14, 15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazaki et al. (US 5108228).

Miyazaki et al. discloses a sub-ducting apparatus comprising a sub-duct (1) and a remotely operable path-finding element (member 2 and part of member 1 near member 2) arranged to facilitate insertion of the sub-duct into a duct (c ). The path-finding element is capable of negotiating a path through an obstruction in the duct (this is the case since member 2 has a dome shape). The sub-duct is an elongate sleeve. The path- finding element is a path-finding head. The head is detachable. The head is outwardly deformable (this is the case when the device is inflated). The head is outwardly deformable at the front end. Means for advancing (see col. 5 lines 30-40).

3. Claims 1-4,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent abstract (05015026).

Japanese Patent abstract discloses a sub-ducting apparatus comprising a sub-duct (1) and a remotely operable path-finding element (3) arranged to facilitate insertion of the sub-duct into a duct (2 ). The path-finding element is capable of negotiating a path through an obstruction in the duct (this is the case since member 3 is capable of

removing dirt etc. that lines member (2)). The sub-duct is an elongate sleeve. The path-finding element is a path-finding head. The head is detachable. Means for advancing (see col. 5 lines 30-40).

4. Claims 1-4,14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Born (US 5988188).

Born discloses a sub-ducting apparatus comprising a sub-duct (14,26, see Figs. 1,2,3) and a remotely operable path-finding element (18, see Figs.8,9a-d) arranged to facilitate insertion of the sub-duct into a duct (12). The sub-duct is an elongate sleeve (see Fig. 2). The path-finding element is a path-finding head. The head is detachable. Means for advancing (see Figs. 4a,b). Obstruction (see Figs. 1,8,10,12,13).

#### ***Response to Arguments***

5. Applicant's arguments filed 9/23/08 have been fully considered but they are not persuasive. Applicant argues that neither Miyazaki et al. nor Japanese document '026 teach a path finding element capable of negotiating a path through an obstruction in a duct. The examiner disagrees. With regards to Miyazaki et al., the path-finding element is capable of negotiating a path through an obstruction in the duct (this is the case since member 2 has a dome shape). With regards to Japanese document '026, the path-finding element is capable of negotiating a path through an obstruction in the duct (this is the case since member 3 is capable of removing dirt etc. that lines member (2)).

Applicant's arguments with respect to claim 15 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/  
Primary Examiner, Art Unit 3672

Sunil Singh  
Primary Examiner  
Art Unit 3672

SS

12/31/08